

REMARKS

Applicants have amended claims 1, 8, 10, 14, 21, 24, 27, 29, 32, 39, 46, 48, 52, 59, 63, 72, 76, 85, 89, 98, 101, and 104 and has added new claims 107-109 as set forth above. In view of the above amendments and the following remarks, reconsideration of the outstanding office action is respectfully requested.

The Office has objected to claim 29 asserting that it appears to depend from an incorrect parent claim. Accordingly, Applicants have amended claims 24 and 29 to depend from claim 21 as set forth above. In view of the foregoing amendments and remarks, the Office is respectfully requested to reconsider and withdraw the objection to claim 29.

The Office has rejected claims 8, 10, 27, 46, 48, 63, 76 and 89 under 35 U.S.C. 112, first paragraph, asserting the claims recite “manufacturing standards” which is not contained in the specification. Accordingly, Applicants have amended claims 8, 10, 27, 46, 48, 63, 76 and 89 as set forth above to replace “manufacturing standards” with “manufacturing data.” By way of example only, support for this amendment can be found on page 8, line 30 to page 9, line 5 in the above-identified patent application. Accordingly, in view of the foregoing amendments and remarks, the Office is respectfully requested to reconsider and withdraw this rejection.

The Office has rejected claims 1, 59 and 98 under 35 U.S.C. 101 asserting that the language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory material under 35 U.S.C. 101. The Office asserts that it appears the recited steps can be performed by a person using pencil and paper. Additionally, the Office has rejected claims 21 and 101 under 35 U.S.C. 101 asserting the claimed invention is directed to non-statutory subject matter asserting that it appears these steps do not require hardware, and are at best directed to an arrangement of software, and are therefore not tangible.

Applicants respectfully traverse the Office’s rejection and direct the Office’s attention to the decision by the United States Patent and Trademark Office Board of Patent Appeals and Interferences (US BPAI) in, *Ex parte Lundgren, Appeal No. 2003-2088 (BPAI 2005)*, which was decided after the mailing date of this Office Action and which eliminated the “technological arts” test in determining eligible patentable subject matter for business method claims. Accordingly, the Office’s rejection of claims 1, 59, and 98 because the

Office asserts the claim is not tied to a technological art, environment or machine and the Office's rejection of claims 21 and 101 because the Office asserts these steps do not require hardware is no longer a valid rejection. In view of the foregoing remarks, the Office is respectfully requested to reconsider and withdraw these rejections.

The Office has rejected claims 1-2, 4, 7, 11 - 18, 20-23, 26, 29-36, 38-40, 42, 45, 49 - 56, 58, 65-67, 70-71, 78-80, 83-84, 91-93, 96-97 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,581,045 to Watson (Watson) in view of Onodera, Katsuhige; "Effective Techniques of FMEA at Each Life-Cycle Stage", 1997, Proceedings of the Annual Reliability and Maintainability Symposium (Onodera), claims 59-62, 72-75 and 85 -88 are rejected under 35 U.S.C. 102(b) as being anticipated by Watson, claims 5-6, 24-25 and 43-44 under 35 U.S.C. 103(a) as being unpatentable over Watson and Onodera, in view of MIL-STD-1629A, "Military Standard procedures for performing a failure mode, effects and criticality analysis", 24 November 1980 (MilStd1629A), claims 8-9, 27-28 and 46-47 under 35 U.S.C. 103(a) as being unpatentable over Watson and Onodera, in view of U.S. Patent 6,052,631 to Busch (Busch), claims 63-64, 76-77 and 89-90 under 35 U.S.C. 103(a) as being unpatentable over Watson in view of Onodera, further in view of Busch, claims 68-69, 81-82 and 94-95 under 35 U.S.C. 103(a) as being unpatentable over Watson in view of MilStd1629A, claims 19, 37 and 57 under 35 U.S.C. 103(a) as being unpatentable over Watson and Onodera, in view of U.S. Patent 6,151,565 to Loble (Loble), claims 98, 100, 101, 103, 104 and 106 under 35 U.S.C. 103(a) as being unpatentable over Watson in view of Loble, and claims 99, 102 and 105 under 35 U.S.C. 103(a) as being unpatentable over Watson and Loble, in view of Eckenrode Robert T.; "Weighting multiple criteria", 1965, Management Science, Volume 12, Number 3 (Eckenrode).

The Office asserts Watson discloses: determining an overall condition of each of the items based on obtained data (column 3, lines 32-50; and column 5, lines 55-67; and column 6, lines 1 -17 and 29 - 45); determining whether each of the items satisfies one or more operation specifications based on the obtained data (column 3, lines 32 - 50; and column 4, lines 13-20; and column 8, lines 40 - 47; especially the performance estimate factor); and assessing a plurality of remanufacturing options for each of the items based on the determined overall conditions for each of the items to identify which of the plurality of remanufacturing options are viable (column 4, lines 35 - 42; and column 5, lines 55 - 67; and column 6, lines 8-18; and column 9, lines 5 - 48, especially lines 44 - 48). The Office also Watson discloses: obtaining one or more assessments of the one or more items (column 3,

lines 32 - 50; and column 5, lines 55 - 67; and column 6, lines 1 -17 and 29 - 45) and assessing a plurality of remanufacturing options for each of the items based on the one or more assessments to identify which of the plurality of remanufacturing options are viable (column 4, lines 35 - 42; and column 5, lines 55 - 67; and column 6, lines 8-18; and column 9, lines 5 - 48, especially lines 44 -48).

Watson, Onodera, MilStd1629A, Busch, Lobley, and Eckenrode, alone or in combination, do not disclose or suggest, “determining a risk priority of each of the items based on the obtained data . . . assessing a plurality of remanufacturing options for each of the items based on the determined overall condition, the determined satisfaction of the operation specifications, and the determined risk priority for each of the items to identify which of the plurality of remanufacturing options are viable” as recited in claims 1 and 39, “a risk priority processing system that determines a risk priority of each of the items based on the obtained data; and a remanufacturing assessment processing system that assesses a plurality of remanufacturing options for each of the items based on the determined overall condition, the determined satisfaction of the operation specifications, and the determined risk priority for each of the items to identify which of the plurality of remanufacturing options are viable” as recited in claim 21, “obtaining one or more assessments of the one or more items regardless of a condition of each item; and assessing a plurality of remanufacturing options for each of the items based on the one or more assessments to identify which of the plurality of remanufacturing options are viable” as recited in claims 59 and 85 and “an item assessment processing system that obtains one or more assessments of the one or more items regardless of a condition of each item; and a remanufacturing assessment system that assesses a plurality of remanufacturing options for each of the items based on the obtained one or more assessments to identify which of the plurality of remanufacturing options are viable” as recited in claim 72.

As the Office has acknowledged, Watson does not disclose a risk priority of each of the items based on the obtained data. In fact, as disclosed in the Abstract and on col. 4, lines 43-50 in Watson which discloses that data representative of defects is received and stored and then the feasibility of repair or replacement of the stored defects is analyzed. Accordingly, Watson is only focused on evaluating defects and not each of the items in a system for remanufacturing regardless of the condition of an item. In Watson, non-defective elements are never evaluated or form part of a remanufacturing assessment process. Accordingly, even if Watson is taken in view of Onodera as suggest by the Office, it would

only apply the risk analysis to the defects, not to each item in an apparatus. Similarly, none of the other cited references disclose or suggest the claimed combination.

As disclosed on page 3, lines 7- 13 of the above-identified patent application, “As a result, an apparatus remanufactured based on the assessment in accordance with the present invention will be designed to take into account factors relating to risk priority, such as the potential for failure and effect of a failure of systems, subsystems, and/or components within the apparatus. The assessment for remanufacturability should have greater reliability and/or better performance because of this risk priority analysis.” (Emphasis added).

Additionally, the Office attention is respectfully directed to FIG. 10 and page 22, line 8 to page 23, line 12 in the above-identified patent application which illustrates an assessment for remanufacturing which includes items in good condition and recommends remanufacturing options for items in good condition.

Accordingly, in view of the foregoing amendments and remarks, the Office is respectfully requested to reconsider and withdraw the rejection of claims 1, 21, 39, 59, 72, and 85. Since claims 2-20 depend from and contain the limitations of claim 1, claims 22-38 depend from and contain the limitations of claim 21, claims 40-58 depend from and contain the limitations of claim 39, claims 60-71 depend from and contain the limitations of claim 59, claims 73-84 depend from and contain the limitations of claim 72, and claims 86-97 depend from and contain the limitations of claim 85, they are distinguishable over the cited references and are patentable in the same manner as claims 1, 21, 39, 59, 72, and 85.

Watson, Onodera, MilStd1629A, Busch, Loble, and Eckenrode, alone or in combination, do not disclose or suggest, “determining a measurement criteria score for each of the plurality of remanufacturing options based on the determined weight and the determined rating” as recited in claims 98 and 104 or “determining a measurement criteria score for each of the plurality of remanufacturing options based on the determined weight and the determined rating” as recited in claim 101.

Contrary to the Office’s assertions there is no motivation to combine Watson with Loble. The Office has cited to col. 1, lines 19-36 and col. 2, lines 28-35 in Loble for support for a motivation to combine. However, col. 1, lines 19-36 in Loble, simply states that prior decision support system calculate a weighted average, compare the weighted averages and then presents the highest weighted average as the most preferred and col. 2, lines 29-35 in Loble is simply a generic, boilerplate statement that the system and method in Loble obviates the prior art. Nowhere has the Office provided any support for a motivation

to one of ordinary skill in the art to take the particular aspects of the disclosure in Lobley and combine it in the asset management system taught by Watson.

Accordingly, in view of the foregoing remarks, the Office is respectfully requested to reconsider and withdraw the rejection of claims 98, 101, and 104. Since claims 99 and 100 depend from and contain the limitations of claim 98, claims 102 and 103 depend from and contain the limitations of claim 101, and claims 105 and 106 depend from and contain the limitations of claim 104, they are distinguishable over the cited references and are patentable in the same manner as claims 98, 101, and 104.

In view of all of the foregoing, applicant submits that this case is in condition for allowance and such allowance is earnestly solicited.

Respectfully submitted,

Date: February 6, 2006

Gunnar Leinberg
Gunnar G. Leinberg
Registration No. 35,584

NIXON PEABODY LLP
Clinton Square, P.O. Box 31051
Rochester, New York 14603-1051
Telephone: (585) 263-1014
Facsimile: (585) 263-1600

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450

transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (703) _____.

2/6/2006
Date

Sherri A. Moscato
Signature

Sherri A. Moscato
Type or Print Name